Virgin Records America, Inc v. Thomas Doc. 322

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

CAPITOL RECORDS INC.; SONY BMG MUSIC ENTERTAINMENT; ARISTA RECORDS LLC; INTERSCOPE RECORDS; WARNER BROS. RECORDS INC.; and **UMG RECORDINGS INC.**, *Plaintiffs*, v. **JAMMIE THOMAS**, *Defendants*.	Case No. 06-cv-1497 (MJD/RLE) JURY DEMANDED

MEMORANDUM IN SUPPORT OF OBJECTION TO ADMISSION OF NON-CERTIFIED COPIES OF SOUND RECORDINGS AND OTHER TESTIMONY TO PROVE CONTENTS OF COPYRIGHTED WORKS

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We object to all extrinsic evidence of the works in which the plaintiffs claim to have registered copyrights. The only admissible evidence of these works is certified copies of the works deposited with the Copyright Office along with the plaintiffs' applications for registration. Because the plaintiffs have failed to produce certified deposit copies, they may not introduce evidence — whether by CD's purporting to be copies of the deposited works or by testimony of witnesses who have compared these CD's to the MP3 files from KaZaA — of what the deposit copies contain. Without evidence of what the deposit copies contain, the plaintiffs cannot prove that the MP3 files from KaZaA are copies of registered works and therefore cannot offer evidence on an essential element of their claims for copyright infringement.

Our best case is *King ex rel. King v. Ames*, No. 3:95-cv-3180-G, 1997 WL 327019 (N.D. Tex. 1997). *King* came before the court on cross-motions, the plaintiff's for judgment on the verdict and the defendants' for judgment as a matter of law notwithstanding the verdict. The defendants argued that the plaintiffs had failed to prove the "copying" element of copyright infringement because they had failed to produce a deposit copy of their sound recordings, but instead had testified as to the similarity between the alleged copy and the copyrighted work. Judge Fish held that testimony was insufficient; without the deposit copies, there could be no proof of copying and the defendants were entitled to judgment as a matter of law notwithstanding the jury verdict.

The court's reasoning is worth quoting at length:

> Collectibles and Ames contend that there is no legally sufficient evidentiary basis to support the jury's finding of infringement because, at trial, King failed to produce the copies of the sound recordings she deposited with the United States Copyright Office ("Copyright Office") when she sent in the three registration certificates. Collectibles' Motion at 7-8; Ames' Motion at 8. King argues that she testified at trial as to the

contents of the recordings she deposited with the Copyright Office and moves to supplement the record to include the deposit copies. Motion for Judgment on the Verdict ("King's Motion") at 3-4.

To establish the element of copying, King must show that Collectibles and Ames had access to the copyrighted recordings and that there is substantial similarity between the recordings and the products marketed by Collectibles and Ames. *See Norma Ribbon*, 51 F.3d at 47; *Plains Cotton Cooperative Association of Lubbock, Texas v. Goodpasture Computer Service, Inc.*, 807 F.2d 1256, 1260 (5th Cir.), cert. denied, 484 U.S. 821 (1987).

Two separate components underlie proof of actionable copying. First is the factual question whether the alleged infringer actually used the copyrighted material to create his own work. Copying as a factual matter typically may be inferred from proof of access to the copyrighted work and "probative similarity." . . . The second and usually more difficult question is whether the copying is legally actionable. This requires a court to determine whether there is substantial similarity between the two works.

Engineering Dynamics, Inc. v. Structural Software, Inc., 26 F.3d 1335, 1340-41 (5th Cir.1994) (citations omitted), *modified on reh'g on other grounds*, 46 F.3d 408 (5th Cir.1995). *See also Feist Publications, Inc. v. Rural Telephone Service Company, Inc.,* 499 U.S. 340, 361 (1991). "Even when plaintiff can show access, there is no infringement if the similarities between the works are not sufficient to prove copying." *Folio Impressions, Inc. v. Byer California,* 937 F.2d 759, 765 (2d Cir.1991) (*citing Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir.1946)).

One of the bases for the court's decision to deny summary judgment on King's copyright claim was the omission from the summary judgment record of the deposit copies and thus the inability to determine "whether the works that [King] has sued upon are even the same works as those marketed by Collectibles." King, No. 3:95-CV-3180-G, slip op. at 9. Even "after the agony of a full-blown trial," however, *Robbins*, 278 F.2d at 497, the record is still insufficient to establish whether the works in which King claims a copyright interest are the same as those marketed by Collectibles or Ames. The omission is fatal to King's copyright infringement claim because she bears the burden to prove copying. *Engineering Dynamics*, 26 F.3d at 1340 ("To establish copyright infringement, a plaintiff must prove ... copying ....") (emphasis added); *see also Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir.1984) ("Proof of copying is crucial to any claim of copyright infringement because no matter how similar the two works may be (even to the point of identity), if the defendant did not copy the accused work, there is no infringement."); *Denker v. Uhry*, 820 F.Supp. 722, 728 (S.D.N.Y.1992) ("[T]he copying element of infringement ... is separable into two elements," the first of which is that "plaintiff must prove that defendant actually used plaintiff's work as a source of material ... for his own work."), affd, 996 F.2d 301 (2d Cir.1993) (table).

> At trial, King testified that she deposited with the Copyright Office copies of the recordings marketed by Collectibles and Ames. Transcript, Vol. III at 28-31; see also Plaintiff's Exhibit 48 (summarizing King's testimony). However, substantial similarity depends on a "comparison of the works" and not on "credibility." *Folio Impressions*, 937 F.2d at 766. Because the jury did not have any competent evidence before it with which to compare King's copyrighted recordings and the products of Collectibles and Ames, a finding of probative similarity cannot be sustained. *See O'Brien v. Thall*, 283 F.2d 741, 742 (2d Cir.1960) (affirming district court's grant of defendant's motion for directed verdict where "[t]here [was] no evidence that the defendant's composition as written has ... any similarities whatever with the plaintiff's composition" and thus "there was no competent evidence to support the plaintiff's claims, either on the issue of copying or unlawful appropriation ....") (emphasis supplied).
>
> Accordingly, Collectibles and Ames are entitled to judgment as a matter of law on King's copyright infringement claim.

Just as in *King*, the plaintiffs in this case are attempting to substitute testimony of witnesses about the content of the deposit copy for the deposit copy itself. Just as in *King*, this evidence is insufficient. The deposit copy that accompanies a copyright registration application is a public record of the contents of a copyrighted work. See 17 U.S.C. § 408; *Nimmer on Copyright*, § 7.17[a] (1981). Deposit copies must be submitted to the Copyright Office prior to initiation of an action for infringement. 17 U.S.C. § 411(a).

The Fifth Circuit reviewed Judge Fish's decision in *King* and affirmed on the same ground, namely, that the plaintiff's testimony was not sufficient to support a finding of infringement in the absence of the deposit copies. The Fifth Circuit wrote:

> The party bringing the copyright claim must prove substantial similarity. *See id.* Consequently, we must determine whether King produced sufficient evidence of substantial similarity between the works copyrighted and the works in question in order to permit a reasonable jury to find in her favor.

> We agree with the district court that she did not. Our decision in *Creations Unlimited v. McCain*, 112 F.3d 814 (5th Cir.1997), is controlling. To determine whether an instance of copying is legally actionable, a side-by-side comparison must be made between the original and the copy to assess whether the two works are substantially similar. *See id.* at 816. While a determination of substantial similarity should typically be left to the fact-finder, the *Creations Unlimited* decision contemplates that a fact-finder will have the opportunity to view the two works side-by-side. Indeed, as our sister circuit has found, copying is an issue to be determined by comparison of works, not credibility. *See Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 766 (2nd Cir.1991). King's failure to adduce evidence for such a comparison vitiates her claim.

King v. Ames, 179 F.3d 370, 375–76 (5th Cir. 1999).

Deposit copies define the limits of the infringement action. *E. Mishan & Sons, Inc. v. Marycana, Inc.*, 662 F.Supp. 1339, 1346 (S.D.N.Y.1987) ("action may be maintained only to vindicate infringement of [plaintiffs] work deposited with the registration"). In particular, at trial, evidence of the contents of the deposit copy is necessary to prove infringement because the infringement action is limited to the works that were registered, and the deposit copy is the public record of the contents of actionable works.

The purpose of deposit copies is twofold: (1) archival, in that a copy is kept in the Library of Congress; and (2) evidentiary, in that the deposit copy is proof of what was registered. As the Northern District of Illinois explained:

> Section 407 of Title 17 of the United States Code requires the holder of every copyright for works published in the United States to deposit two complete copies of the underlying work with the Register of Copyrights for the use of the Library of Congress. See 17 U.S.C. § 407(a), (b). This mandatory deposit requirement is separate from the registration-deposit requirement found in § 408. *See generally, Ladd v. Law & Technology Press*, 762 F.2d 809, 812-14 (9th Cir.1985) (recounting the historical development of the two separate deposit requirements). Mandatory deposit furthers a public function by "provid[ing] the Library of Congress via the Copyright Office with copies and phonorecords of all works published within the United States." *Nimmer on Copyright* § 7.17[A], pp. 7-190.3-90.4. **The registration-deposit requirement is a private action that**

> **"create[s] a written record of the copyright ownership in a work."** Id. § 7.17[A], p. 7-190.4.

Rudnicki v. WPNA 1490 AM, 580 F.Supp.2d 690, 693 (N.D.Ill. 2008) (emphasis added).

Nimmer explains the importance of deposit copies to prove what was copyrighted:

> deposit has a copyright as well as an archival function in that in an infringement action it permits a determination of whether the work which the copyright owner claims to have been infringed is in fact the same work in which copyright was originally claimed

Nimmer § 7.17[a]

Where a comparison must be made between the accused and protected work to find infringement, the plaintiff must produce a copy of the protected work. *See Seiler v. Lucasfilm, Inc.*, 808 F.2d 1316, 1319 (9th Cir. 1986) ("There can be no proof of 'substantial similarity' and thus of copyright infringement unless Seiler's works are juxtaposed with Lucas' and their contents compared . . . the contents are material and must be proved"); *Sun Media Systems, Inc. v. KDSM, LLC*, 576 F.Supp.2d 1018, 1021 (interpreting Seiler to require summary judgment in favor of defendant where plaintiff fails to produce originals of protected work); *Stewart v. Wachowski*, 574 F.Supp.2d 1074, 1103 (C. D. Cali. 2004) ("Because Stewart bears the burden of proof on striking similarity, her failure to submit the Terminator and Matrix films in opposition to the motions necessitates the entry of summary judgment against her.").

In the present case, the defendant is accused of infringing a sound recording, which requires an even more stringent standard of comparison than other copyrights. *See Bridgeport Music, Inc v. Dimensions Films*, 410 F.3d 792, 800 (6th Cir. 2005) (". . . the world at large is free to imitate or simulate the creative work fixed in the recording so long as an actual copy of the sound recording itself is not made."); Bradley C. Rosen, Esq., 22 CAUSES OF ACTION § 12 (2d ed. 2003) (“The scope of inquiry is much narrower when the work in question is a sound recording. The only issue is whether the actual sound recording has been used without authorization”); *Fharmacy Records v. Nassar*, 248 F.R.D. 507, 528 (E.D. Mich. 2008) (“The protection afforded sound recordings in a digital sampling case such as the one now before the Court, therefore, does not extend to the “generic sound”; it only protects the recorded sound—the stored electronic data digitally preserved by the composer”).

The statute and cases establish the plaintiff must prove that the allegedly infringing work is a copy of the work on which the plaintiff has registered a copyright — that is, that the allegedly infringing work is a copy of the deposit copy. To meet this burden, the plaintiff must prove up a deposit copy: the plaintiff must prove what it filed with the copyright office. A deposit copy filed with the copyright office is a matter of public record under Rule 1005. Under Rule 1005, such a record may be proved only by certified copy in compliance with Rule 902, or by testimony of a witness who has compared the copy to the original — here, the original in the copyright office. *See also* F.R.C.P. 44; *U.S. v. Childs*, 5 F.3d 1328, 1335 (9th Cir. 1993) ("If the exhibits in question were introduced to prove the content of public records as such, the government would have been required to comply with Rule 1005"). So too under Rule 1002: “To prove the content of a writing, recording, or photograph, the original writing, recording, or photograph is required, except as otherwise provided in these rules or by Act of Congress.”

The 10-series rules encompass sound recordings in the definition of “writings and recordings”. F.R.E. 1001(1). A writing or recording defined by Rule 1001 consists of "letters, words, or numbers, or their equivalent." The phrase "or their equivalent" has been interpreted broadly to encompass such expressions as musical recordings on cassette and drawings. *See Cartier v. Jackson,* 59 F.3d 1046 (10th Cir 1995) (determined musical recordings on cassette were recordings within meaning of Rule 1001(1)); *Seiler v. Lucasfilm*, 808 F.2d1316, 1318-1319 (9th Cir. 1986) ("We hold that Seiler's drawings were "writings" within the meaning of Rule 1001(1); they consist not of "letters, words, or numbers" but of "their equivalent." To hold otherwise would frustrate the policies underlying the rule and introduce undesirable inconsistencies into the application of the rule.").

There is a clearly established procedure for obtaining certified copies of sound-recording deposits form the Copyright Office. That procedure is set out in the Copyright Office's Circular 6, which is attached to this motion. Secondary evidence of the contents of a public record can be given only if "a copy which complies with [either Rule 902 or the rule of witness testimony] cannot be obtained by the exercise of reasonable diligence." F.R.E. 1005. When the plaintiffs obtained certified copies of their Form SR's, they could also have obtained certified copies of the attached sound recordings; they chose not to do so. More importantly, the plaintiffs have never provided deposit copies in this case, certified or otherwise. The defendant simply has had no opportunity to compare the MP3 files she is accused of downloading and sharing with the songs that the plaintiffs actually registered. This is a fatal defect in evidence. It cannot be cured at this late date.

Respectfully submitted,

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